

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Lewin et al.

Serial No.: 10/066,954

Group Art Unit: 3728

Filed: February 4, 2002

Examiner: J. Pickett

For: A METHOD AND APPARATUS FOR THE BULK
COLLECTION OF TEXTURIZED STRAND

REQUEST FOR REHEARING

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In accordance with 37 C.F.R. 41.52(a)(3), Appellant respectfully requests a rehearing of the Decision on Appeal mailed by the Board on April 1, 2009, entering a new ground of rejection against claims 15-18.

Before addressing the grounds for rehearing, a review of the history is believed to be in order. The Examiner rejected claim 15 as being obvious in view of U.S. Patent No. 4,569,471 to Ingemasson, from which the present appeal was taken. In its decision, the Board agreed with the Appellant and reversed this rejection, finding that "[t]he Examiner has not adequately shown that it would have been obvious to use texturized glass at the recited density" of claim 15. Rather than remanding the application, the Board entered a new ground of rejection of claims 15-18 under 35 U.S.C. Section 103(a) based on the combination of a newly cited reference, U.S. Patent No. 4,555,447 to Sieloff et al., in view of the Galanes reference cited by the Examiner.

Appellant agrees that reversal of the appealed rejections is proper, but respectfully submits that the following errors were made by the Board in entering the

new ground of rejection.

As noted by the Board, “Sieloff teaches a method where ‘streams of glass, centrifuged from a spinner, engaged by a vertically downwardly directed annular gaseous blast for attenuating the centrifuged streams of fibers’ are used to produce glass wool” (Sieloff et al., col. 2, ll. 65-68). Appellant respectfully submits that the process described in the cited section of Sieloff et al. is a process for directly forming glass wool where “molten glass is delivered to a rotating cylinder the face of which is perforated with a large number of holes. Glass streams, projected laterally from the holes by centrifugal force, are then attenuated into discontinuous fibers by a high velocity gas stream.” (The Handbook of Glass Manufacture, Fay V. Tooley, editor, Ashlee Publishing, New York, New York, 1984, Vol. II, page 725, emphasis added.) Moreover Sieloff et al. goes on to state: “In such processes the vertically moving fibers are collected in random disposition in a mass upon the conveyor.” (col. 3, ll. 2-4, emphasis added)

In contrast, as also noted by the Board, Appellant’s specification teaches that “the texturized product is typically created by expanding a continuous strand of glass fibers.” (Spec. 3, l. 34 to 4, l. 1, emphasis added)

Appellant therefore submits that Sieloff et al. teaches discontinuous fibers, and not glass strands as defined in Appellant’s Specification (Spec. 1, l.12 to l. 21, emphasis added):

“A strand of glass filaments is typically formed by attenuating molten glass through a plurality of orifices in a bottom plate of a bushing. ... The filaments are gathered in parallel relationship to form a strand. In conventional filament forming systems, the streams of glass have been attenuated by winding the filaments on an exterior of a rotating tube.”

Appellant therefore submits that Sieloff et al. nowhere teaches or suggests strands of any kind, let alone a glass strand in texturized, coiled form as recited in Claim 15. Appellant submits that the discontinuous fibers of Sieloff et al. are nowhere taught as being in coiled form.

As another point of error, the Board in its decision to reject claim 15 anew expressly made the factual finding that “Sieloff teaches that ‘[d]ensities of glass fiber material in the range of about 0.2 to 20 pounds per cubic foot may be used in this invention.’” Appellant does not disagree with the accuracy of this statement, which is taken directly from the Sieloff patent at col. 3, lines 53-54. However, Appellant also points to the Board’s factual finding that the present specification “teaches that the ‘texturized product is typically created by expanding a continuous strand of glass fibers.’” Appellant further notes that it is this particular “texturized” product that has the density range set forth in the pending claims.

Claim 15 is thus plainly directed not to just “glass fiber material having a density in the range of about 0.2 to 20 pounds per cubic foot,” per Sieloff et al., but rather glass strand in a texturized, coiled form. Further, this claim requires that this texturized, coiled glass strand “has a density of 5 to 10 lbs/ft³.” This texturized strand “is continuous strand that has been expanded or texturized” such that “[t]he fibers in the strand are separated to give the strand a full, wool-like appearance”. Appellant’s Specification, page 1, ll. 29-31.

In entering the new ground of rejection, the Board expressly acknowledged that the density range of Sieloff et al. refers to the glass fiber material *per se* and not after it has been processed in any way. Indeed, the very next sentence of the Sieloff reference following the passage cited by the Board explains that “the cured wool has a density of 0.4 lb/ft³ to 1.0 lb/ft³,” and clearly it is this “cured wool” that is “produced and bagged.” Hence, Appellant respectfully submits that Sieloff et al. does not supply the missing teaching that, according to the Board’s decision, renders the invention of claim 15 obvious.

The Board also finds that the new rejection is proper by relying on the concept of encompassing ranges. As noted above, the range of the bagged, cured wool in Sieloff et al. is “0.4 lb/ft³ to 1.0 lb/ft³.” This of course is about 10-12 times less than the claimed range of “5 to 10 lbs/ft³.” As there is thus no encompassing, the burden-shifting approach announced in the *Peterson* decision relied upon by the Board does

not apply, and the PTO thus continues to bear the burden of establishing a *prima facie* case of obviousness.

Appellant also takes issue with the statement in the Board's analysis of Sieloff et al., that this reference "teaches that the glass strand can be withdrawn [from a bag] for subsequent use." (emphasis added). Support for this teaching is allegedly found in "Factual Finding 11" from the Board's decision. However, this factual finding says nothing whatsoever about withdrawing "glass strand" for subsequent use. What Sieloff actually teaches is that, during bagging, "[t]he columns [not coils] break up at random" (col. 3, lines 67-68). Hence, contrary to the Board's statement, there is no "teaching" that any "strand" can be withdrawn from any container, and Factual Finding 11 thus does not support the rejection made.

Objection is also made to the Board's reliance on inherency in determining that "the resulting glass wool" of Sieloff et al. "will inherently comprise some level of coiling as evidenced by the teaching of" Appellant's specification. A finding of inherency requires that it is "necessarily" the case that the cited condition results. *Scaltech, Inc. v. Retec/Tetra, LLC.*, 178 F.3d 1378, 1384, 51 USPQ2d 1055, 1059 (Fed. Cir. 1999) ("An inherent limitation is one that is necessarily present"). The "mere possibility" that the condition exists, which is what the Board seems to rely upon, is simply insufficient to support a finding of inherency. *Id.*

The Board here does not explain why it is "necessarily" the case that the strand in Sieloff et al. is coiled because of a "gaseous blast" of "some flow and pressure." Appellant's specification teaches that "[t]he texturized strand 80 has a coiled shape that is imparted on the strand by the nozzle 20." (page 5, ll. 35-36, emphasis added). The Board does not establish by any substantial evidence that the "gaseous blast" mentioned in Sieloff et al. would "necessarily" produce the claimed coil in the absence of the "texturizer" or nozzle 20. Moreover, as noted above, the "gaseous blast" of Sieloff et al. produces discontinuous fibers, and not strands or texturized strands.

The Board's position also appears to rely on Appellant's specification in support of the rejection. This type of hindsight-based approach is clearly not proper under precedential decisions. *See, e.g., W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1555, 220 USPQ 303, 314 (Fed. Cir. 1983) (“[t]o imbue one of ordinary skill in the art with knowledge of the invention [under consideration], when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.”). Significantly, the U.S. Supreme Court recently reaffirmed that “[a] factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of argument reliant upon *ex post* reasoning,” *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 USPQ2d at 1397. *See also Graham v. John Deere Co.*, 383 U.S. at 36, 148 USPQ at 474. Here, when the only support in the record for a teaching of the claimed coiled, texturized fiber of the invention is found in the present specification, Appellant respectfully submits that such prohibited *ex post* reasoning is being applied.

In summary, Appellant has addressed and met the new rejection in the Decision on Appeal and respectfully submits that all of the rejected claims meet the statutory requirements for patentability. Thus, it is respectfully requested that all outstanding rejections of claims 15-18 be withdrawn and that the present application be remanded to the Examiner with instructions for immediate allowance.

Respectfully submitted,

OWENS CORNING

Date: May 29, 2009

By: Kathryn W. Grant
Kathryn W. Grant
Reg. No. 33,238

Owens Corning
2790 Columbus Road, Route 16
Granville, Ohio 43023-1200
(740) 321-7213